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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Timothy R. Spooner

Analog 5721-3

1808

7590

02/09/2005

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EXAMINER

DICKEY, THOMAS L

ART UNIT

PAPER NUMBER

2826

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/006,964

Applicant(s)

SPOONER ET AL.

Examiner

Thomas L Dickey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30,32,34,37,38,40,42-95,97,99 and 102-145 is/are pending in the application.
- 5) ☒ Claim(s) 2,4,8,10,13,15,19,21,23,25-30,32,34,38,40,42-49,51,53,57,59,61,63-68,82,84,89,91-95,97,99,102-108,110,112,115,117-121,124,125,133,134 and 142 is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,9,11,12,14,16-18,20,22,24,37,50,52,54-56,58,60,62,69-81,83,85-88,90,109,111,113,114,116,122,123,126-132,135,136,138-140 and 144 is/are rejected.
- 7) ☒ Claim(s) 137,141,143 and 145 is/are objected to.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. The amendment filed on 12/13/2004 has been entered.

### ***Drawings***

2. In order to avoid abandonment, the drawing informalities noted in the paper mailed on 10/01/2004, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

The drawings remain objected to by the PTO Draftsperson for the reasons noted on the Notice of Draftsperson's Patent Drawing Review, form PTO-948, attached to the Paper mailed 10/01/2004.

### ***Double Patenting***

3. Claims 49-60, 109, and 114 were previously objected to under 37 CFR 1.75 as being either duplicates or substantial duplicates of claims 12-22, 30, 87 and 88 (note that claim 88, dependent from claim 81 through claim 86 but otherwise identically worded to claim 87, recites each and every limitation of claim 87, with the additional, claim 81, limitation that the wafer cap be a cover tape). However, due to amendments to claims 49-60, 109, and 114, duplication is now avoided.

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4. Claims 1,6,7,12,17,18,50,55,56,69-71, 77-79, 81,86-88, 109,114, 122,123, 126-128, 130-132,135, 140, and 144 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,11, and 18-20 of U.S. Patent No. 6,555,417. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1,11, and 18-20 of U.S. Patent No. 6,555,417 recite a laminated MEMS wafer (LMW) and a method for making a protected MEMS structure, (a) said LMW comprising a MEMS wafer having a plurality of MEMS structure sites thereon, and said method comprising a step of preparing said wafer; (b) said LMW further comprising a static dissipative spacer layer mounted upon the MEMS wafer, the static dissipative spacer layer being perforated in areas corresponding to locations of the MEMS structure sites on the MEMS wafer (said method further comprising a step of mounting said static dissipative spacer layer); and (c) said LMW further comprising a static dissipative cover tape wafer cap mounted upon said static dissipative spacer layer to produce a laminated MEMS wafer (said method further comprising a step of mounting said static dissipative cover tape wafer cap); (d) said LMW further comprising a static dissipative contiguous tape applied to a backside of said MEMS wafer, the backside of said MEMS wafer being a side opposite of a side having said static dissipative cover tape wafer cap located thereon (said method further comprising a step of applying said static dissipative contiguous tape either before, or after the wafer cap is mounted on the MEMS wafer). Whether the claimed spacer layer has a thickness to prevent damage to at least one MEMS structure (preventing damage

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to at least one MEMS structure being the broadest reasonable reading of the claimed function "prevent damage to the MEMS structures"), to prevent said wafer cap coming into physical contact with said MEMS wafer and to prevent electrostatically induced damage to said MEMS wafer is a matter for conjecture. One would assume that following the method claimed in U.S. Patent No. 6,555,417 would produce at least some undamaged MEMS structures. The presumption of validity of 6,555,417 seems to compel this assumption, because without some small yield of useful MEMS structures it would appear that the '417 claimed method lacks utility. However, even if the '417 method need not produce usable devices to meet the legal definition (35 USC 101) of having utility, it would still have been obvious to modify the '417 method (if indeed, such modification was necessary) so that the spacer layer had a thickness to prevent said wafer cap deflecting to damage the MEMS structures and to prevent electrostatically induced damage to said MEMS wafer, in order to produce some yield of useful MEMS chips due to a decrease in electrostatically or physically damaged chips, to thus prevent the loss of the complete yield of the '417 method, and the subsequent economic problems associated with performing an expensive semiconductor method without getting anything back to show for one's efforts.

5. Claims 1,6,12,17,24, 43,50,55,62,81,86-88,90, 109,114, and 116 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,22,28-33, 35,56, and 62-67 of copending Application No. 10/006,966. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because although claims 1,22,28-33, 35,56, and 62-67 of copending Application No. 10/006,966 are narrower than the current claims they recite, in passing, each of the limitations of claims 1,6,12,17,24, 43,50,55,62,81,86-88,90, 109,114, and 116 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1,24,81, and 90 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26,1,32,44, and 45 of copending Application No. 10/007,585. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 44 and 45, although narrower than claims 1,24,81, and 90 of the instant application, nonetheless recite each and every limitation of said claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claim 37, 74, 75, 76, 129, and 138 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 37 line 1 "the cover tape" has no antecedent basis.

B. Claims 74, 75, 76, 129, and 138 depend from claim 73, which purports to depend from claim 31, a cancelled claim. The text of cancelled claim 31 being unavailable renders the purported dependent claims indefinite.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. Claims 1,3,5,6,9,11,12,14,16,17,20,22,50,52,54,55,58,60,81,83,85-88, 109,111,113 and 114 are rejected under 35 U.S.C. § 102(b) as being anticipated by ROBERTS ET AL. (5,362,681).

Roberts et al. discloses a laminated MEMS wafer (LMW) and a method for making a protected MEMS structure, (a) said LMW comprising a MEMS wafer 32 having a

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plurality of MEMS structure sites thereon, and said method comprising a step of preparing said wafer 32; (b) said LMW further comprising a spacer layer 26 mounted upon the MEMS wafer 32, the spacer layer 26 being perforated in areas 28 corresponding to locations of the MEMS structure sites on the MEMS wafer 32 (said method further comprising a step of mounting said spacer layer 26); and (c) said LMW further comprising a cover tape wafer cap (no part #, it is the "3 mil Mylar film" mentioned first in column 7 lines 33-40) mounted upon said spacer layer 26 to produce said LMW (said method further comprising a step of mounting said cover tape wafer cap); said spacer layer 26 having a thickness; wherein the spacer layer 26 comprises a flexible film made of Mylar, Mylar being transmissive to UV radiation (in the near-UV range), with an adhesive medium (here, note column 6 line 10) on one side. Note figures 3,5 and column 4 lines 5-15, 42-47, column 6 lines 8-12, column 7 lines 33-40, and column 8 lines 14-20 of Roberts et al.

The applicant's claims do not distinguish over the Roberts et al. reference regardless of the functions allegedly performed by the claimed device, because only the device per se is relevant, not the recited functions of preventing electrostatically induced damage to the MEMS wafer, preventing said wafer cap coming into physical contact with said MEMS wafer and preventing the wafer cap from deflecting in such manner as to damage the MEMS wafer.

Note that functional language in a device claim is directed to the device per se, no matter which of the device's functions is referred to in the claim. See *In re Ludtke and*



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*Sloan*, 169 USPQ 563 at 567, and *In re Swinehart* 169 USPQ 226, both of which make it clear that it is the patentability of the device per se which must be determined in a “functional language” claim and not the patentability of the function, and that an old or obvious device alleged to perform a new function is not patentable as a device, whether claimed using “functional language,” or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear. See also *In re Schreiber*, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997), for a discussion of the roles of examiner and applicant in determining when and how functional limitations distinguish a claim from prior art disclosing the same structure.

**B.** Claims 1,3,6,9,12,14,17,20, 50,52,55,58, 69,70,72,77, 78,80,81, 83,86-88, 109,111,114,140, and 144 are rejected under 35 U.S.C. § 102(e) as being anticipated by GLENN (6,465,329).

Glenn discloses a laminated MEMS wafer (LMW) and a method for making a protected MEMS structure, (a) said LMW comprising a MEMS wafer 3 having a plurality of MEMS structure sites 2 thereon, and said method comprising a step of preparing said MEMS wafer 3; (b) said LMW further comprising a spacer layer 12 mounted upon the MEMS wafer 3, the spacer layer 12 being perforated in areas 28 corresponding to locations of the MEMS structure sites 2 on the MEMS wafer 3 (said method further comprising a step of mounting said spacer layer 12); (c) said LMW further comprising a cover tape wafer cap 26 mounted upon said spacer layer 12 to produce said laminated MEMS wafer (said method further comprising a step of mounting said cover tape wafer

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cap 26); and (d) said LMW further comprising a contiguous tape 34 applied on a backside of the MEMS wafer 3, the backside of the MEMS wafer 3 being a side opposite of a side having the wafer cap located thereon (said method further comprising a step of applying said contiguous tape 34); said spacer layer 12 being a "conventional sticky tape" (note column 6 line 11) and thus comprising a flexible film with an adhesive medium on one side, wherein the contiguous tape 34 is applied to the backside of the MEMS wafer 3 after the wafer cap is mounted on the MEMS wafer 3, and before the laminated MEMS wafer (LMW) is sawn. Note figures 1,3 and 7 and column 1 line 55-61 (making clear that when Glenn writes "microcircuit" he means "MEMS"), column 6 lines 1-24, 48-51, column 7 lines 1-13 and 50-57 of Glenn.

The applicant's claims do not distinguish over the Glenn reference regardless of the functions allegedly performed by the claimed device, because only the device per se is relevant, not the recited functions of preventing electrostatically induced damage to the MEMS wafer, preventing said wafer cap coming into physical contact with said MEMS wafer, and preventing the wafer cap from deflecting in such manner as to damage the MEMS wafer.

Note that functional language in a device claim is directed to the device per se, no matter which of the device's functions is referred to in the claim. See *In re Ludtke and Sloan*, 169 USPQ 563 at 567, and *In re Swinehart* 169 USPQ 226, both of which make it clear that it is the patentability of the device per se which must be determined in a "functional language" claim and not the patentability of the function, and that an old or

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obvious device alleged to perform a new function is not patentable as a device, whether claimed using "functional language," or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear. See also *In re Schreiber*, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997), for a discussion of the roles of examiner and applicant in determining when and how functional limitations distinguish a claim from prior art disclosing the same structure.

***Allowable Subject Matter***

9. Claims 2, 4, 8, 10, 13, 15, 19, 21, 23, 25-30, 32, 34, 37, 38, 40, 42-49, 51, 53, 57, 59, 61, 63-68, 82, 84, 89, 91-95, 97, 99, 102-108, 110, 112, 115, 117-120, 121, 124, 125, 133, 134, and 142 are allowed over the references of record because none of these references disclosed or can be combined to yield the claimed invention such as:

A. A method having all the limitations of the method of claim 1, as that claim was rejected on 10/01/2004, and the further limitation of mounting a spacer tape comprising a tape having adhesive on two sides, and a flexible film, as recited in claim 2.

B. A method having all the limitations of the method of claim 31, as that claim was rejected on 10/01/2004, and the further limitation of mounting a spacer tape comprising a tape having adhesive on two sides, and a flexible film, as recited in claim 32.

C. A method having all the limitations of the method of claim 50, as that claim was rejected on 10/01/2004, and the further limitation of mounting a spacer tape comprising a tape having adhesive on two sides, and a flexible film, as recited in claim 51.

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D. A laminated MEMS wafer having all the limitations of the laminated MEMS wafer of claim 81, as that claim was rejected on 10/01/2004, and the further limitation of a spacer tape comprising a tape having adhesive on two sides, and a flexible film, as recited in claim 82.

E. A laminated MEMS wafer having all the limitations of the laminated MEMS wafer of claim 96, as that claim was rejected on 10/01/2004, and the further limitation of a spacer tape comprising a tape having adhesive on two sides, and a flexible film, as recited in claim 97.

F. A laminated MEMS wafer having all the limitations of the laminated MEMS wafer of claim 109, as that claim was rejected on 10/01/2004, and the further limitation of a spacer tape comprising a tape having adhesive on two sides, and a flexible film, as recited in claim 110.

10. Claim 37 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

11. Claims 137, 141, 143, and 145 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

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***Response to Arguments***

12. Applicant's arguments filed 12/13/2004 have been fully considered but they are not persuasive.

It is argued, at page 24 of the remarks, that "Various claims have been rejected or provisionally rejected under the doctrine of obviousness double-patenting. However, since the some of the claims that the Examiner has indicated as containing allowable subject matter have not been rejected or provisionally rejected under the doctrine of obviousness double-patenting, the Applicants request that these rejections under the doctrine of obviousness double-patenting be held into abeyance until the Examiner has actually indicated that the application contains allowed claims." The Examiner lacks the power to hold a rejection of any kind "in abeyance." The claims in question stand rejected, as indicated above. This action is made final, as indicated below.

It is argued, at page 24 of the remarks that "The Examiner alleges that the alleged functional language of the claims is not relevant." This is simply untrue. What the Examiner wrote was: "only the device per se is relevant, not the recited functions of preventing electrostatically induced damage to the MEMS wafer and preventing damage to the MEMS structures due to the wafer cap coming into physical contact with the MEMS wafer." Every word applicant uses is relevant. See *In re Swinehart*, 169 USPQ 226,229 ("We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that "functional"

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language, in and of itself, renders a claim improper"). Functional language that defines a distinction between the claimed device and the prior art is entirely proper. But such functional language defines a distinction that rests entirely on the inability of the prior art device to perform the function performed by the claimed device.

It is argued, at page 25 of the remarks, that "Initially, the language of amended independent claim 1, which the Examiner is apparently ignoring, is not merely functional language. More specifically, amended independent claim 1 explicitly states that the spacer layer has a thickness to prevent electrostatically induced damage to the MEMS wafer. In other words, the spacer layer has a physical dimension or structure that is defined by its ability to prevent electrostatically induced damage." However, defining structure in terms of its abilities is the very essence of what is called "functional language." See *In re Swinehart*, 129 USPQ at 228 ("We take the characterization "functional", as used by the Patent Office and argued by the parties, to indicate nothing more than the fact that an attempt is being made to define something ... by what it does rather than by what it is"). Again, the Examiner has not "ignored" Applicant's functional limitations. The Examiner simply insists that the record be clear that Applicant has not simply discovered that the prior art device has abilities not hitherto known, but rather that Applicant has in fact discovered a new device.

It is further argued, at page 25 of the remarks, that "Moreover, the Examiner has failed to show or demonstrate, other than using a blanket allegation, that the physical structure of the spacer layer taught by Roberts et al., a spacer layer having a thickness

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of preferably 5 mils (column 6, lines 8-9), is able to prevent electrostatically induced damage to the wafer." The Examiner has previously explained his reasoning for why the physical structure is able to prevent electrostatically induced damage to the wafer, but he will restate it briefly here. 1) Roberts et al. produces a useful device. 2) A useful device is not damaged. 3) A device that has undergone electrostatically induced damage has been damaged in some way. Roberts et al.'s device, being useful and hence undamaged, belongs in one class (the class of undamaged devices). Electrostatically damaged devices belong in a class (the class of damaged devices) that is mutually exclusive to the class (the class of undamaged devices) to which Roberts et al.'s device belongs. Further, while it is true that the favored embodiment of Roberts et al. has a spacer layer thickness of 5 mils, it is equally true, and more on point, that a functional limitation such as that used in claim 1 covers all embodiments performing the recited function. See, for example, *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 68 USPQ2d 1865, 1873 (Fed. Cir 2003) ("By its terms, a "synergistically effective amount" is a functional limitation. As explained in *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971), a functional limitation covers all embodiments performing the recited function. Thus, this claim term should not be limited to the disclosed dosage range of 50 mg to 500 mg but instead should encompass any dosage amount that can achieve therapeutic synergy.")

On pages 26-27, again on pages 27-28, and finally on pages 28-30 Applicant repeats the argument of pages 25-26 exactly, word-for-word, changing only the words

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"claim 1," into "claim 50," "claim 81," and "claim 109," respectively. On page 30 Applicant concedes that the only difference between Applicant's invention as claimed in claims 3,5,6,9,11,12,14,16,17,20,22, 52,54,55,58,60,81,83,85-88, 109,111,113 and 114, is found in the functional language ("to prevent electrostatically induced damage to the MEMS wafer") common to claims 1,50,81, and 109. Applicant's sole argument for the patentability of claims 1,3,5,6,9,11,12,14,16,17,20,22,50,52,54,55,58,60,81,83,85-88, 109,111,113 and 114 over Roberts et al. is thus his pointing out that, regardless of whether the device disclosed by Roberts et al. is capable of preventing electrostatically induced damage, the teachings of Roberts et al. "fail to provide any discussion or suggestions, explicitly or implicitly, with respect to preventing electrostatically induced damage to the MEMS wafer." Remarks at pages 25,27,28, and 30.

Without going into details, it is noted that Applicant's sole argument for the patentability of claims 1,3,5,6, 9,11, 12,14,16,17,20,22,50,52,54,55,58,60,81,83,85-88, 109,111,113 and 114 over Glenn et al. is his pointing (in language precisely the same as the language Applicant uses regarding Roberts et al.) out that, regardless of whether the device disclosed by Glenn et al. is capable of preventing electrostatically induced damage, the teachings of Glenn et al. "fail to provide any discussion or suggestions, explicitly or implicitly, with respect to preventing electrostatically induced damage to the MEMS wafer." Remarks at pages 32,33,35, and 36.

However, it does not suffice for Applicant to merely assert that Roberts and Glenn do not teach the prevention of electrostatically induced damage (although these



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references do teach the making of useful, and apparently undamaged, devices), and challenge the Examiner to prove otherwise. See *In re King*, 231 USPQ 136, 139 (Fed. Cir 1986) ("Here, appellant's burden before the board was to prove that Donley's structure does not perform the so-called method defined in the claims when placed in ambient light. Appellant did not satisfy that burden. It did not suffice merely to assert that Donley does not inherently achieve enhanced color through interference effects, challenging the PTO to prove the contrary by experiment or otherwise. The PTO is not equipped to perform such tasks.")

The Applicant is urged to re-read the case law the Examiner has cited. For example, in *In re Schreiber*, the Court held: "The examiner and the Board both addressed the question whether the functional limitations of Schreiber's claim gave it patentable weight and concluded that they did not, because those limitations were found to be inherent in the Harz prior art reference ... [T]he examiner was justified in concluding that [the Harz prior art reference was capable of performing Schreiber's claimed function]. The examiner therefore correctly found that Harz established a prima facie case of anticipation. At that point, the burden shifted to Schreiber [emphasis added] to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus. See *In re Spada*, 911 F.2d at 708, 15 USPQ2d at 1658; *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986); *In re Best*, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1976)." *In re Schreiber*, 44 USPQ 1429, 1432 (Fed. Cir 1997). See also *In re Ludtke and Sloan*, 169 USPQ 563, 567

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(CCPA 1971) ("Thus, since the only alleged distinction between claims 1-6 and Menget is recited in functional language, it was incumbent upon appellants, when challenged, to show that the canopy disclosed by Menget does not actually possess such characteristics") and *In re Swinehart*, 169 USPQ 226 (CCPA 1971) ("[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on"). Please further note that although the cited passage from *In re Swinehart* is, as applicant notes, a CCPA case, it is quoted, with approval, in *In re Schreiber*, 44 USPQ2d 1429 at 1432 (Fed. Cir, 1997).

In the case at hand, it is the Examiner's finding that the spacer layer of Roberts et al. presumably had a thickness capable of preventing electrostatically induced damage to the MEMS wafer, since (Roberts et al. being an issued US Patent) the method and device of Roberts et al. has presumptive utility, and electrostatically induced damage to the MEMS wafer, were it to have existed, would destroy said utility. The Examiner in no way assumes that Applicant's functional limitations are incapable of helping define a claim to a device that is distinct from the one disclosed by Roberts et al. The Examiner simply points out that, in keeping with Federal Circuit/CCPA precedent, the burden has shifted to Applicant to show that Roberts et al.'s prior art spacer layer does not

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inherently possess the functionally defined limitations of Applicant's claimed spacer layer.

### ***Conclusion***

**13. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas L Dickey whose telephone number is 571-272-1913. The examiner can normally be reached on Monday-Thursday 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**TLD**  
**02/05**

  
**Minhloan Tran**  
**Primary Examiner**  
**Art Unit 2826**